

DETAILED ACTION

1. This Office Action follows a response filed on September 12, 2008. Claims 1, 14, and 16 have been amended; 7, 8, 10, 13, 21, 22, and 26 have cancelled; no claims have been added.
2. In view amendment(s) and remarks, the rejection of claims 1 and 3-27 under 35 U.S.C. § 103(a) as being unpatentable as obvious over Khan et al. al. ("ABA triblock comb copolymers with oligo(oxyethylene)side chains as matrix for ion transport", *Makromolekulare Chemie*, 190, 1069-1078 (1988)) in view of Giles et al. (U. S. Patent 5,196,484) has been withdrawn.
3. Applicant's arguments with respect to claim 1, 3-6, 9, 11, 12, 14-20, 23-25 and 27 have been considered but are moot in view of the new ground(s) of rejection.
4. This is the second non-final rejection.
5. Claims 1, 3-6, 9, 11, 12, 14-20, 23-25 and 27 are active.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1, 3-6, 9, 11, 12, 14-20, 23-25 and 27 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 9, 10, 25, 26, 33, 34, 56, 77, 96, and 97 of copending Application No.10/571,998. Although the conflicting claims are not identical, they are not patentably distinct from each other because current application and Application No.10/571,998 both describe a solid polymer electrolyte comprising an electrolyte salts, and a copolymer which contains a block chain A represented by formula (I), a block chain B represented by formula (II), and a block chain C represented by formula (III).

Regarding the limitation of claims 1 and 16 of current application that the copolymer exhibits a microphase separated structure, it is the examiner position that in view of substantially identical composition between copending application 10/571,998 and instant claims, it is the examiner position that the claimed copolymer inherently possesses this property. Since the USPTO does not have equipment to do the analytical test, the burden is now shifted to the applicant to prove otherwise. **In re Fitzgerald** 619 F 2d 67, 70, 205 USPQ 594, 596 (CCPA 1980).

It is worth to mention that copending application 10/571,998 clearly discloses that the copolymer has a microphase separated structure (page 34, (85)).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Applicant has provided evidence in this file showing that the invention was owned by, or subject to an obligation of assignment to, the same entity as copending application 10/571,998 at the time this invention was made, or was subject to a joint research agreement at the time this invention was made. However, reference 10/571,998 additionally qualifies as prior art under another subsection of 35 U.S.C. 102, and therefore, is not disqualified as prior art under 35 U.S.C. 103(c).

Applicant may overcome the applied art either by a showing under 37 CFR 1.132 that the invention disclosed therein was derived from the invention of this application, and is therefore, not the invention "by another," or by antedating the applied art under 37 CFR 1.131.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL M. BERNSHTEYN whose telephone number is (571)272-2411. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/523,085
Art Unit: 1796

Page 6

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Examiner, Art Unit 1796

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